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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,288	03/12/2004	Michael T. Costello	0178-PA	8266
7590 Michael P. Dilworth Crompton Corporation Benson Road Middlebury, CT 06749				
EXAMINER				
GOLOBOY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
01/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/800,288

**Applicant(s)**

COSTELLO ET AL.

**Examiner**

James Goloboy

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. Claims 1 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Crompton Corporation and Fields.

This rejection is adequately set forth in paragraph 3 of the office action mailed 9/2/09. Csikos discloses concentrations of antioxidant and biocide encompassing the claimed amounts.

***Response to Arguments***

2. The claims have been amended to limit the concentrations of antioxidant and biocide to 0.25% by weight each. However, the results are still not commensurate with the scope of the claims for several reasons:

i) Claims 1 and 41 recite "a metalworking fluid". "Metalworking fluid" is not defined in the application as originally filed and is therefore considered to encompass a wide range of lubricants, including oil-in-water emulsions, water-in-oil emulsions, aqueous compositions, and oil-based compositions. Applicant has only demonstrated results for a specific type of metalworking fluid, and therefore the claim needs to define the components of the metalworking fluids for which unexpected results are obtained.

ii) The inventive examples contain components such as "SOB", "R14D", and "Shell MM 100" which are not defined anywhere in the application, so the

examiner cannot ascertain precisely what is contained in the compositions in order to determine what is commensurate with the scope of the claims.

iii) The unexpected results appear to be obtained when the sample compositions are used as oil-in-water emulsions. However, the compositions disclosed in the specification appear to be the oil phase only, and the concentrations recited in the claims appear to refer to concentrations within just the oil phase.

iv) Additives such as Naugalube 438L and "Butylated DPA" are not purely butylated diphenylamine, but butylated octylated diphenylamine, as disclosed in the table following paragraph 32 of the specification (PG Pub 2004/0204326). The claim should recite the amount of butylated and octylated diphenylamine.

v) The limitation regarding biological degradation in claims 1 and 41 should specify the incubation time, as results are reported for several incubation times.

vi) Example 4 in table 1 of the specification, which allegedly shows unexpected results for a composition comprising butylated diphenylamine, is outside the scope of the current claims, as it gives a bomb life of only 34 minutes.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797